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Date: 7/26/06By: Patti Hespell
Patti HespellMAIL STOP AFIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of John Schlack.

Conf. No.: 7949 : Group Art Unit: 2623
Appln. No.: 09/766,004 : Examiner: Manning, John
Filing Date: 19 January 2001 : Attorney Docket No.: T721-21
Title: System and Method for Delivering Statistically Scheduled Advertisements

Request for Pre-Appeal Brief Conference

Applicant(s) request(s) review of the final rejection in the above-identified application, under the Pre-Appeal Brief Conference Program published on July 12, 2005. No amendments are being filed with this request.

- ☒ The review is requested for the reason(s) stated on the attached sheet(s).
☒ Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences is filed herewith.

Date: 7/26/06

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Application No. 09/766,004

STATEMENT IN SUPPORT OF REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Presently, claims 1-38 are pending in the application. This paper is being filed in support of the Request for Pre-Appeal Brief Conference submitted herewith. Details of the Examiner's rejections may be found in the Final Office Action dated January 27, 2006 ("Final Office Action") and the Examiner's Advisory Action dated July 7, 2006 ("Advisory Action"). Discussion of the prior art references and the pending claims may be found in Applicant's Amendment filed December 7, 2005 ("Amendment") and Applicant's Response After Final Rejection filed May 5, 2006 ("Response After Final"), both of which are incorporated herein by reference.

No Prima Facie Case of Obviousness

Even though the Examiner has not established a *prima facie* case for obviousness, the Examiner has not withdrawn the rejection of claims 1, 2, 9, 11-14, 16-20, 21, 31-35, and 37-38 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,463,585 B1 to Hendricks et al. ("Hendricks") in view of International Patent Application Publication No. WO 00/33233 to Eldering et al. ("Eldering"). A summary of the Examiner's reasons for this rejection may be found at page 4 of Applicant's Response After Final.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references, when combined) must teach or suggest all of the claim limitations. See MPEP 2143.

Applicant has submitted that Hendricks in view of Eldering does not teach all elements of the Applicant's claims (Response After Final, page 2). In particular, Hendricks in view of Eldering does not teach or suggest a "plurality of presentation stream groups each corresponding to a particular programming channel, each of the presentation stream groups composed of a plurality of multiple presentation streams that are carrying the same programming and the same avails, each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule," as recited in independent claim 1.

In maintaining the final rejection, the Examiner argues that the "mentioned default *targeted* advertisement is a *targeted* advertisement," (Advisory Action, page 2). Such a statement, however, does not show that claim 1 is obvious over Hendricks in view of Eldering. Although the default targeted

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advertisement in Hendricks may be targeted, claim 1 recites a "plurality of presentation stream groups...composed of a plurality of multiple presentation streams...each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule." Therefore, a single programming stream containing a single targeted advertisement (i.e., as in Hendricks) does not teach this aspect of claim 1.

The Examiner seems to believe that the default targeted advertisement in Hendricks in a group of programs sent to one set top box ("STB") is different than the default advertisement in the same group of programs sent to another STB. This is incorrect. In Hendricks, a group of programs that is sent to one particular headend/STB grouping contains the same default targeted advertisement as the same group of programs that is sent to other different headends/STB groupings. The Examiner seems to believe that Fig. 31 shows different default targeted advertisements being included in programming streams directed to different advertiser specific markets. However, Fig. 31 actually shows how different groupings may have different switching plans to switch to the appropriate feeder channel, but not that different groupings have different default advertisements. For instance, in Set Top Terminal Grouping C, for the Sports Category, the switching plan indicates that feeder channel I should be switched to, etc. For Set Top Terminal Grouping C, in the case of a Children or Entertainment Program Categories, a D is indicated, which means the default targeted advertisement should be shown. In this case, no switching will occur because the default targeted advertisement is included in the programming stream.

Further, the Examiner seems to believe that in Hendricks, the default targeted advertisement is scheduled according to the switching plan. This too is incorrect; the default target advertisement is not determined by the switching plan. As indicated in the Response After Final, page 4, the default targeted advertisement is the advertisement that is "most appropriate to the overall audience, in case feeder channels are not available for alternative targeted advertising," (see Hendricks column 27, lines 57-59). Only the default targeted advertisement is included in the programming stream. Alternative advertisements are provided via separate feeder channels. There is only one default targeted advertisement per avail slot in each programming stream.

The Examiner argues that Hendricks teaches that the "default that is shown on the regular programming channel will correlate with one of the assigned set top groupings and program categories," (Advisory Action, page 3). Applicant is unsure as to how the Examiner intended this statement to substantiate the aspects of claim 1 that are not otherwise taught by Hendricks. Here, Hendricks describes one way in which the default targeted advertisement may be targeted. That is, Hendricks suggests that

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the default targeted advertisement can be targeted to the most appropriate overall audience. Hendricks may do this by selecting the group that best represents the best overall audience.

Moreover, claim 1 recites that advertisements are "directed to different advertiser-specific market segments according to the ad schedule." The default targeted advertisement in Hendricks is not directed to different advertiser-specific market segments according to an ad schedule or anything resembling an ad schedule. Hendricks teaches that the default targeted ad is targeted according to what is appropriate for the overall audience that is likely to view the associated programs. The feeder channels are selected according to a switching plan. As such, Hendricks teaches that the feeder channels are not carried with part of the presentation stream. Never, however, does Hendricks teach or suggest a "plurality of presentation stream groups... composed of a plurality of multiple presentation streams... each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule."

In view of the foregoing, the Examiner has failed to acknowledge the difference between the inserted default targeted advertisement and the feeder channel that is selected and substituted according to the switching plan. Clearly, the feeder channels are not included in the presentation stream; otherwise they could not be switched or tuned to. Claim 1 recites that the presentation streams are "carrying advertisements directed to different advertiser-specific market segments according to the ad schedule." not that a feeder channel is switched to provide the targeted advertisement. Further, the default targeted advertisement is not switched to according to the switching plan and certainly is not targeted according to the switching plan. Thus, switching to a feeder channel is not the same as "plurality of presentation stream groups each corresponding to a particular programming channel, each of the presentation stream groups composed of a plurality of multiple presentation streams that are carrying the same programming and the same avails, each of the presentation streams carrying advertisements directed to different advertiser-specific market segments according to the ad schedule."

In light of the fact that Hendricks in view of Eldering does not teach or suggest all of the features of independent claim 1, the Examiner has not met the burden of establishing a prima facie case for obviousness. Accordingly, for the reasons detailed herein as well as in Applicant's Amendment and Response After Final, independent claim 1, independent claim 21, and all claims dependent thereon, are allowable over Hendricks in view of Eldering.

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Applicant respectfully submits that the Examiner's rejections have been previously overcome, and that the application, including claims 1-38, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and a Notice of Allowance are respectfully requested.